

**REMARKS**

Review and reconsideration of the Office Action of December 18, 2003, is respectfully requested in view of the above amendments and the following remarks.

The specification has been amended to provide an antecedent basis for the subject matter of claim 10, without adding new matter to the Specification.

Applicant has amended the claims to overcome the Examiner's rejection. Care has been taken to ensure that no new matter is added to the claims. Support for the amendment to Claims 1-10 is found in the Specification.

**Present Invention**

The present invention teaches a process for the structuring of a paper poster or paper photograph, for the plastic reproduction, true to the original, of oil paintings.

**Office Action**

Turning now to the Office Action in greater detail, the paragraphing of the Examiner is adopted.

**Paragraph 1 (Specification)**

The Examiner objects to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner states that the limitations of claim 10 should be recited in the specification.

In response, Applicant has added paragraph [0017] to the specification to provide written support in the description for the matter of Claim 10 though importing the wording of Claim 10 into the specification. As decided in *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA1980) the claims are their own written description, and resultantly, no new matter has been added by way of this amendment.

Applicant respectfully requests that the objection to the specification be withdrawn.

**Paragraphs 2 - 11 (Claim Rejections - 35 USC § 112)**

Claims 1-10 were rejected by the Examiner under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In response, Applicant has made numerous amendments to the claims to overcome the objections under 35 USC 112. In Claim 1, the phrase "fixing the paper copy" has been replaced with "fixing the paper copy to the matrix" as suggested by the Examiner. Applicant has amended the phrase "adhering a canvas onto the back surface of the paper copy" to read "adhering a canvas onto the back surface of the paper copy to form a laminate". Applicant has amended the step of cold surface pressing to recite "cold surface pressing the laminate into the matrix at least once to structure the laminate with the surface structure of the matrix". Claim 2 has been amended to recite "The process according to claim 1, wherein the matrix is an imprint of an original painting and the paper copy is a print of the original painting in its original size." Claims 7 and 9 have been amended as suggested by the examiner.

Applicant states that amended Claim 1 recites the steps of a process for producing a three-dimensional surface structure in a paper copy of a picture, the paper copy being in the form of a paper poster or paper photograph having an image side. The steps of this process include:

placing the paper copy with the image side down onto a matrix having a surface structure and fixing the paper copy to the matrix, the paper copy being equal in size to or smaller than the matrix;

adhering a canvas onto the back surface of the paper copy to form a laminate;

cold surface pressing the laminate into the matrix at least once to structure the laminate with the surface structure of the matrix;

removing the resulting structured laminate of the paper copy and the adhered canvas, after the pressing, from the matrix and mounting the laminate under tension onto a frame; and

sealing the structured laminate.

In view of the above amendments, Applicant requests that the objection to the claims under 35 USC 112, second paragraph, be withdrawn.

**Paragraphs 12 - 16 (Claim Rejections - 35 USC § 103)**

The Examiner rejected Claims 1-3, 5, 7, 8, and 10 under 35 U.S.C. 103(a) as being unpatentable over Falk (US Patent No. 3,964,946) in view of Lang et al. '063 (US Patent No. 5,182,063) and Baratto (US Patent No. 5,721,041). Further, Claim 4 was rejected over Falk in view of Lang '063, Lang '734, and/or

Barnett and Giorgi. Furthermore, Claim 6 was rejected in view of the above listed references, and further in view of Robinson.

Applicant traverses this rejection as follows.

In response, Applicant respectfully submits that none of the three references, either alone or in combination, teach or teach toward the invention of amended Claim 1.

Falk teaches a process whereby a print of an oil painting is given the surface texture of a canvas on which an oil painting would be produced. Claim 1 is directed at a process whereby a print of a painting is given the surface structure of the painting on which it is based. The teachings of Falk are, in many ways, directed away from the matter claimed in amended Claim 1. While both the matter claimed in amended Claim 1 and the matter taught in Falk are directed at giving a paper copy of a picture surface structure, Applicant submits that the surface structure obtained using the method taught by Falk is obtained by pressing the paper copy of the picture into a backing, whereas amended Claim 1 requires pressing a laminate of the paper copy and a canvas into a matrix. Thus, in Falk the matrix which gives surface structure is the backing to the paper copy of the picture. As a result, Applicant submits that Falk teaches away from the present invention. While amended Claim 1 recites "placing the paper copy with the image side down onto a matrix having a surface structure", Falk teaches placing the paper copy with the image side up so that when pressed, the picture obtains the surface structure of the matrix to which it is laminated. Applicant further submits that Falk teaches the lamination of the paper copy to the matrix, which directly teaches away from the step of removing the structured laminate from the matrix. Applicant submits that the teachings of Falk

do not teach towards the same result as that achieved by amended Claim 1, and as a result, Applicant submits that one skilled in the art would not look toward Falk, alone or in combination with other references, to arrive at the matter claimed in amended Claim 1.

Lang et al. does teach the placing of a paper copy on a matrix having a surface structure, as well as the use of cold pressing, however, Applicant submits that Lang et al. teaches away from the matter claimed in amended Claim 1. Amended Claim 1 recites both fixing the paper copy to the matrix and adhering a canvas onto the back surface of the paper copy to form a laminate. While Lang et al. is silent of fixing the paper copy to the matrix, it specifically teaches away from the creation of a laminate. In column 12, at lines 29-32, Lang et al. states "...the printed image is not placed on a carrier laminated to another substrate." Applicant submits that this teaches away from "adhering a canvas onto the back surface of the paper copy to form a laminate" as recited in amended Claim 1. Applicant further notes that Lang et al. teaches neither mounting the laminate under tension onto a frame or sealing the structured laminate. In place of sealing, Lang et al. teaches the use of a hot stamp foil that can be "applied on the image surface of the embossing material 256." Applicant submits that both this step and the lack of a laminate carrier teach away from the matter claimed in amended Claim 1.

The Examiner cited Baratto to show that the step of mounting the laminate under tension onto a frame was known in the art. However, Baratto relates to creating an impression of a painting using a thermoplastic film in place of a paper copy (see column 5, paragraph beginning line 27). The use of a

thermoplastic film obviates the need for creating a laminate, and additionally requires both heating and the creation of a vacuum to cause the thermoplastic film to distort and take the shape of a mould (see column 7 lines 16-24). Applicant submits that one skilled in the art, wishing to arrive at the matter claimed in Claim 1 would never consult Baratto, as its teachings do not apply to forming a paper, or paper based laminate, to a matrix (the heating step as taught by Baratto would not soften the paper and indeed may ignite the paper).

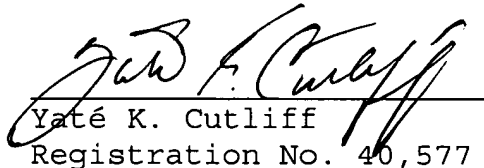
Thus, Applicant submits that though Falk teaches the creation of a laminate, it teaches laminating the paper copy of the picture to the matrix. Neither Lang, nor Baratto teach toward the use of a laminate, and in fact teach away from its use. None of the cited references teach cold surface pressing a laminate into the matrix, and resultingly none teach the removal of the structured laminate from the matrix. Accordingly Applicant submits that none of the references cited against Claim 1, alone or in combination, teach toward the creation of a laminate; pressing the laminate into a matrix to structure the laminate with the surface structure of the matrix; and removing the laminate from the matrix. Furthermore, Applicant suggests that in view of the teachings of the cited art, neither Falk nor Baratto would be considered as teaching toward the process of amended Claim 1 and would not have been referred to by one skilled in the art seeking to arrive at the matter claimed by amended Claim 1. Additionally, Lang et al. distinctly teaches away from the creation of a laminate, while not teaching the fixing of the paper copy to the matrix, and as a result even in combination with the other references would not have taught the matter of amended Claim 1.

Applicant respectfully requests that the rejection of Claim 1 under 35 USC 103(a) be withdrawn.

As Claims 2-10 all depend, either directly or indirectly from Claim 1, Applicant submits that they are not obvious in view of the cited art. Applicant submits that the further art cited against the dependent claims cannot be used in combination with the references cited against claim 1 to create a mosaic, sufficiently compact, to adequately teach the matter claimed. As a result, Applicant requests that all the rejections to Claims 2-10 under 35 USC 103(a) be withdrawn.

All claims are now in condition for allowance. Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully requested to contact the undersigned at the indicated telephone number.

Respectfully submitted,

  
Yaté K. Cutliff  
Registration No. 40,577

PENDORF & CUTLIFF  
5111 Memorial Highway  
Tampa, FL 33634-7356  
(813) 886-6085

Date: **March 18, 2004**

U.S. Application No. 10/067,108  
AMENDMENT A

Attorney Docket No.: 3648.031

**CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE**

I hereby certify that the foregoing AMENDMENT A for U.S. Application No. 10/067,108 filed February 2, 2002, was deposited in first class U.S. mail, postage prepaid, addressed: Attn: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **March 18, 2004**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.

  
Yaté K. Cutliff